



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/736,617 | 12/13/2000 | Douglas S. Makofka | 18926-004400US | 8900 |
| 20350 | 7590 | 02/27/2006 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | SALCE, JASON P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2614 | |

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/736,617 | Applicant(s) MAKOFKA ET AL. | |
| | Examiner Jason P. Salce | Art Unit 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/1/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2614

DETAILED ACTION

Response to Arguments

1. The declarations filed on 12/01/2005 under 37 CFR 1.131 are sufficient to overcome the Safadi reference.

Claim Objections

2. Claim 8 is objected to because of the following informalities: Claim 8 contains exclamation points. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2614

3. Claims 1, 3-8, 10-15 and 17-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12 and 15 of Safadi (U.S. Patent No. 6,256,393) in view of Maillard (U.S. Patent No. 6,393,562). Although the conflicting claims are not identical, they are not patentably distinct from each other (see table and discussion below).

| Instant Application 09/827,545 | Patent 6,256,393 |
|---|--|
| <p>1. A method for controlling access to a functional unit within a set top box.</p> <p>receiving first information comprising a plurality of functional unit identifiers</p> <p>and one or more tier requirements respectively related to each functional unit identifier</p> <p>receiving second information comprising tier rights</p> <p>correlating the functional unit identifiers to their respective tier requirements</p> <p>interacting with the functional unit</p> <p>determining if the respective tier requirements are satisfied by the tier rights and authorizing further interaction with the functional unit</p> | <p>1. A method for providing authorization and access control of software object residing in digital set-top terminals</p> <p>1. downloading the association table containing the information generated in said encoding step (note that the associate table contains <u>a fingerprint for each software object</u>)</p> <p>1. downloading the association table containing the information generated in said encoding step (note that the association table contains <u>a service tier associated with each fingerprint</u>)</p> <p>1. transmitting a message, providing an indication of what software the set-top terminal may utilize</p> <p>1. creating an association table containing the information generated in the encoding step</p> <p>12. determining if the use of a set-top terminal resource has been requested</p> <p>15. wherein the second system routine uses the transmitted messages to determine if the software object may utilize the requested set-top terminal resource</p> |

| | |
|---|---|
| receiving third information that replaces the tier rights | Obvious in view of Maillard (see below) |
|---|---|

Safadi ('393 Patent) fails to disclose receiving third information that replaces the tier rights.

Maillard discloses the distribution of multiple EMMs, which replaces a previously sent EMM with a current EMM (according to the date information) (see Column 6, Lines 53-55 and Lines 60-64 and Column 7, Lines 10-16 and Lines 22-29 for replacing tier rights data of a previous EMM data with the current EMM data).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the set top box, as taught by Safadi, using the EMM data verification receiver, as taught by Maillard, for the purpose of preventing fraudulent access in a conditional access system linked to a subscriber's receiver/decoder (see Column 1, Lines 9-10 of Maillard).

Referring to claim 3 of the instant application, see claim 6 of the '393 patent.

Referring to claim 4 of the instant application, see claim 7 of the '393 patent.

Referring to claim 5 of the instant application, see claim 7 of the '393 patent (for a teaching of software).

Referring to claim 6 of the instant application, see claim 1 of the '393 patent for reciting that a software object has been downloaded and not broadcasted (streamed), therefore the downloading of a software object teaches the receipt of a plurality of non-streaming content functional units.

Referring to claim 7 of the instant application, the '393 patent is silent for the set-top box being integral with an enclosure for a display.

Maillard teaches that a set top box can be connected to a television set 2002 in Figure 1 (also note Column 4, Lines 62-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the set top box, as taught by Safadi, using the EMM data verification receiver, as taught by Maillard, for the purpose of providing the functionality of being able to view the received view data from the broadcast center.

Referring to claim 8, see the table below:

| Instant Application 09/827,545 | Patent 6,256,393 |
|--|---|
| 8. A conditional access system for controlling access to functional units | 28. A system for providing authorization and access control of software object |
| a set top box | a digital set-top terminal |
| a functional unit associated with the set top box | software object residing in digital set-top terminals |
| a requirements message comprising a functional unit identifier and one or more tier requirements related to the functional unit identifier | means for creating an association table/message containing the information generated in said encoding step |
| wherein the functional unit identifier is associated with the functional unit | means for creating a fingerprint for each software object |
| a rights message comprising one or more tier rights | means for transmitting a message, providing an indication of what software the set-top terminal may utilize |
| an authentication function that authenticates a source of the rights and | Obvious in view of Maillard (see below) |

| | |
|---|--|
| requirements messages and an authorization function that compares each of the one or more tier requirements against the one or more tier rights in order to authorize use of the functional unit | Wherein the system routine uses the association table/message to determine if the software object about to be invoked has been authorized for the set-top terminal |
|---|--|

Safadi ('393 Patent) fails to disclose authenticating the source of the rights and requirements messages.

Maillard discloses receiving EMM and ECM messages for providing conditional access to functional units provided to a user (see Column 2, Lines 40-57).

Maillard also discloses that the EMM and ECM that are used in the conditional access system are used to authenticate the source by allowing use and/or viewing of specific types of functional units, such as programs to view or order in a pay per view system (see Column 5, Lines 1-12).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the set top box, as taught by Safadi, using the EMM data verification receiver, as taught by Maillard, for the purpose of preventing fraudulent access in a conditional access system linked to a subscriber's receiver/decoder (see Column 1, Lines 9-10 of Maillard).

Claim 10 corresponds to claim 8, where Maillard further teaches a bi-directional data channel (see Column 5, Lines 21-25).

Claim 11 corresponds to claim 8, where Maillard further discloses the distribution of multiple EMMs, which replaces a previously sent EMM with a current EMM (according to the date information) (see Column 6, Lines 53-55 and Lines 60-64 and

Column 7, Lines 10-16 and Lines 22-29 for replacing tier rights data of a previous EMM data with the current EMM data).

Referring to claims 12-14, see the rejection of claims 6, 5 and 7, respectively.

Referring to claim 15, see the rejection of claim 1.

Referring to claim 17 of the instant application, see claim 10 of the '393 patent (for teaching a non-authorized state).

Referring to claim 18 of the instant application, see claim 1 of the '393 patent for creating a fingerprint for each software object.

Referring to claim 19 of the instant application, see the rejection claim 11 above for receiving replacement rights, thereby providing more than one tier right.

Referring to claims 20-21 of the instant application, see the rejection of claims 5-6 above, respectively.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason P Salce
Patent Examiner
Art Unit 2614

February 17, 2006

A handwritten signature in black ink, appearing to read "Jason Salce", written in a cursive style.